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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 09/930,779 | 08/15/2001 | Jeremy Burr | ITL0658US (P11212) | 2581 |
| 21906 7590 05/21/2010 TROP, PRUNER & HU, P.C. 1616 S. VOSS ROAD, SUITE 750 HOUSTON, TX 77057-2631 | | | | |
| EXAMINER | | | | |
| TRAN, TUAN A | | | | |
| ART UNIT | | PAPER NUMBER | | |
| 2618 | | | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/930,779

Applicant(s)

BURR, JEREMY

Examiner

TUAN A. TRAN

Art Unit

2618

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Statement(s) (PTO/SF/23)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-30 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claimed language of "a contact list of second wireless devices with which the first wireless device has communicated in the past" was introduced in independent claims 1 and 11 and the equivalent claim language "that the system has communicated with before" was introduced in independent claim 21 in the amendment filed May 12, 2005. There is no support for this limitation in the Application as originally filed. The Specification only states: "Each device includes a contact list. A contact list may be a list of individuals with whom the device has communicated in the past " (See Specification, page 4 lines 9-11 and page 5 lines 6-9). The Specification does not state that the contact list "must" be a list of individuals with whom the "first wireless device" has communicated with in the past. Thus, there is no supporting disclosure for the limitations added by amendment.

Allowable Subject Matter

1. Claims 1-30 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, first paragraph, set forth in this Office action.

The following is a statement of reasons for the indication of allowable subject matter:

The closest prior art to the claimed subject matters is Haartsen (6,590,928). Haartsen discloses limitations recited in independent claims 1, 11 and 21 except the contact list is a list of individuals with whom the first wireless device has communicated with in the past.

Response to Arguments

Applicant's arguments and affidavit filed 03/17/2008 have been fully considered but they are not persuasive. See MPEP 1214.01.

While there is no *in haec verba* requirement, newly added claim limitations must be supported in the specification through express, implicit, or inherent disclosure. The trouble is that there is no such disclosure, easy though it is to imagine it. *Purdue Pharma L.P. v. Faulding Inc.*, 230 F.3d 1320, 1328, 56 USPQ2d 1481, 1487 (Fed. Cir. 2000). The Examiner does not question whether the claim language is inconsistent with, or contradictory to, the teachings of the specification (See Specification, page 4 lines 9-11 and page 5 lines 6-9). But, the Examiner maintains that the specification does not **clearly and concisely** disclose to the skilled artisan that the inventors considered this particular contact list must be a list of individuals with whom the "first wireless device" has communicated with in the past. There is support for the contact list that **"mav"** be a list of individuals with whom the "first wireless device" has communicated in the past (See Specification, page 4 lines 9-11 and page 5 lines 6-9), but there is no explicit

support for the contact list that **“must”** be a list of individuals with whom the “first wireless device” has communicated with in the past. The written description requirement was not satisfied because the **disclosure revealed a broad invention from which the later-filed claims carved out a patentable portion.**

The above fact is **explicitly admitted** by the applicant in the applicant's affidavit filed on 03/17/2008. In item #5a of the affidavit, the Declarant himself states that the specification text is broader in scope than the claims. Item #6 then further states that the scope of the claim is narrower than the scope of the disclosure. Both of these points only reinforce the holding of the 112-1st paragraph rejection and Examiner's rebuttal herein.

Further, in response to the applicant's “possible embodiment” arguments stated in Item 5 of the applicant's affidavit, a person skilled in the art might realize from reading the disclosure **that such a step is possible is not a sufficient indication** to that person that the step is part of appellants' invention. Such an indication is the least that is required for a description of the invention under the first paragraph of §112. See *In re Smythe*, 480 F.2d 1376, 178 USPQ 279 (CCPA 1973). Claims added by amendment and drawn to an invention not so described in the specification are drawn to “new matter” and prohibited by §132. (See also: *In re Barker and Pehl*, 194 USPQ 470 (CCPA 1977)).

For those reasons, the rejection under 35 U.S.C. 112, first paragraph is proper and maintained.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TUAN A. TRAN whose telephone number is (571)272-7858. The examiner can normally be reached on Mon-Fri, 10:00AM-6:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew Anderson can be reached on (571) 272-4177. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Tuan A Tran/
Primary Examiner, Art Unit 2618

/Matthew D. Anderson/
Supervisory Patent Examiner, Art Unit 2618